UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/881,815	06/18/2001	Ta-Ching Pong	PONG3002/BEU	9271

23364 7590 11/21/2003

BACON & THOMAS, PLLC
625 SLATERS LANE
FOURTH FLOOR
ALEXANDRIA, VA 22314

EXAMINER	
VU, NGOC K	

ART UNIT	PAPER NUMBER
2611	4

DATE MAILED: 11/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/881,815	PONG, TA-CHING	
	Examiner	Art Unit	
	Ngoc K. Vu	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *18 June 2001*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-15* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-15* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) *2*.
4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

The original claim 13 is misnumbered. Therefore, the original claims 14-16 are renumbered as claims 13-15, respectively.

2. Claims **5** and **6** are objected to because of the following informalities:

Claim **5** recites the limitation "said blue-painted portions of the real-life environment" in line 2. It appears that claim 5 calls for the limitation "blue coloring to potions of a real-life environment" as previously cited in claim 4 at line 2. Thus, please change the limitation "said blue-painted portions of the real-life environment" in line 2 of claim 5 to "said blue coloring to portions of the real-life environment", and also change "a method as claimed in claim 3" in line 1 of claim 5 to "a method as claimed in claim 4. Appropriate correction is required.

Claim **6** recites the limitation "said real-life environment" in line 1. It appears that claim 6 calls for the limitation "a real-life environment" as previously cited in claim 4 at line 2. Thus, please change "a method as claimed in claim 3" to "a method as claimed in claim 4". Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims **3-6** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation cited in claim **3** "similar technology" in lines 2-3 is indefinite. It is not clear what technology is referred to. Appropriate correction is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims **1, 2, 9, 14** and **15** are rejected under 35 U.S.C. 102(b) as being anticipated by Rosser (WO 98/28906).

Regarding **claim 1**, Rosser discloses a method of delivering advertising and/or commercials to a user, viewer, or consumer via composite images displayed to the user, viewer, or consumer through a media display device *(a method for distributing advertisement to an end user via composite video displayed to the user through a video viewing device 56 – see page 9, lines 22-31 and figure 1)* comprising the steps of:

displaying a program or other images *(i.e., displaying a live television broadcast of an event being played on a court 10 – see figure 1; page 8, lines 17-21)*; and

inserting, while said program or other images are being displayed, an advertisement into a selected portion of the displayed program or other images, said advertisement being displayed in a manner appropriate to the content of the displayed program or other images *(as shown in figure 1, an advertisement, i.e., AD1 58 or LOGO B 60, is inserted into a selected portion of the displayed video stream, i.e., live television broadcast of event being played on the*

court 10. It is noted that the insertion of advertisement into the video stream in a way that can make the inserted indicia appear to the end user as if it were part of the original scene 10 – see figure 1; page 10, lines 5-12 and 18-22).

Regarding **claim 2**, Rosser discloses a method as claimed in claim 1, wherein said step of inserting said advertisement comprises the step of merging a simulated image into a broadcast *(for example, merging an image or video to be inserted 90 such as AD1 or LOGO B, into a broadcast, i.e., a base-band video 84 or live video – see figures 1-2; page 10, lines 7-12; page 13, lines 20-27; page 13, line 36 to page 14, line 11).*

Regarding **claim 9**, Rosser discloses that the advertisements are updated with participation by the user, viewer, or consumer *(in particular, by comparing a viewer usage profile keys 120 with a local viewer usage profile 50, different advertisements, i.e., insertions 58 and 60, may be made on different end users video viewing device 56. The different advertisements or the different insertions are downloaded in memory device during or prior to transmission of the live video transmission in which they are inserted. It is noted that the usage profile is a history of the participation of the viewer such as pattern of viewing, which may include type of program, time of day watching the program, duration of watching of the program, etc. That is, the advertisements are targeted to specific viewing profiles. Thus, the advertisements are updated by participation of the viewer - see figure 1 and page 10, lines 19-22 and abstract).*

Regarding **claim 14**, Rosser discloses a system of delivering advertising and/or commercials to a user, viewer, or consumer via composite images displayed to the user, viewer, or consumer through a media display device *(a method for distributing advertisement to an end user via composite video displayed to the user through a video viewing device 56 – see page 9, lines 22-31 and figure 1)*, comprising:

means for displaying a program or other images *(i.e., displaying a live television broadcast of an event being played on a court 10 – see figure 1; page 8, lines 17-21)*; and

means for inserting, while said program or other images are being displayed, an advertisement into a selected portion of the displayed program or other images, said advertisement being displayed in a manner appropriate to the content of the displayed program or other images *(as shown in figure 1, an advertisement, i.e., AD1 58 or LOGO B 60, is inserted into a selected portion of the displayed video stream, i.e., live television broadcast of event being played on the court 10. It is noted that the insertion of advertisement into the video stream in a way that can make the inserted indicia appear to the end user as if it were part of the original scene 10 – see figure 1; page 10, lines 5-12 and 18-22).*

Regarding **claim 15**, Rosser disclose a system as claimed in claim 15, wherein said means for inserting said advertisement comprises means for merging a simulated image into a broadcast program *(for example, merging an image or video to be inserted 90 such as AD1 or LOGO B, into a broadcast, i.e., a base-band video 84 or live video – see figures 1-2; page 10, lines 7-12; page 13, lines 20-27; page 13, line 36 to page 14, line 11).*

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims **3-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser (WO 98/28906) in view of Wilf et al. (US 6,208,386 B1).

Regarding **claim 3**, Rosser discloses merging the simulated image *(for example, merging the image or video to be inserted 90 into the base-band video 84 - see figures 1-2; page 10, lines 7-12; page 13, lines 20-27; page 13, line 36 to page 14, line 11).*

Rosser does not explicitly disclose using "blue screen" technology for the step of merging.

However, Wilf et al. teach using chroma-key or blue screen technology for electronically replacing a real billboard in a video image display by the replacement billboard. By use of the chroma-key technology there is no requirement to transmit any occlusion data since this can be readily inserted at a receiver and the occlusion inserted in the normal manner *(see col. 3, lines 39-42; col. 4, lines 21-24 and 30-32; col. 5, lines 6-20 and 46-47; col. 14, lines 29-33).*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Rosser by using the chroma-key or blue screen technology for replacing a portion of the video image, i.e., real billboard in the video image, by a replacement portion, i.e., replacement billboard, at the receiver as taught by Wilf et al. for the advantage of inserting an image into a video image at the receiver with less cost.

Regarding **claim 4**, the combination teaching of Rosser and Wilf et al. disclose wherein application of the blue screen technology involves adding blue coloring to portions of a real-life environment *(Wilf et al. disclose that the billboard to be replaced is blank and is of colour suitable for chroma-key replacement such as blue– see Wilf: col. 5, lines 53-55).*

Regarding **claim 5**, the combination teaching of Rosser and Wilf et al. disclose wherein real-life environment is a sports venue *(for example, Rosser shows that a live television broadcast of an event such as a sport event being played on a court 10 – see figure 1),* and said blue-painted portions of the real-life environment are areas on which advertisements would normally be displayed, including areas of billboards *(for example, Wilf et al. disclose that*

in an arrangement within a stadium or other sport venue real billboards with normal advertising material will be situated on one side of the stadium to be viewed by a first plurality of cameras and chroma-key billboards will be situated on another or the opposite side to be viewed by a second plurality of cameras – see col. 5, lines 10-15).

Regarding **claim 6**, the combination teaching of Rosser and Wilf et al. does not explicitly show that a real life environment is a musical event. However, the combination teaching of Rosser and Wilf et al. is used in a real life environment such as a sport event wherein advertisements are displayed on background of the event by using blue screen technology *(see Rosser: figure 1 and Wilf: col. 3, lines 39-42; col. 4, lines 21-24 and 30-32; col. 5, lines 6-20 and 46-47; col. 14, lines 29-33)*.

In view of this, Official Notice is taken that it is well known in the art to use the system as taught by Rosser and Wilf et al. for a musical event to present advertisements on the background of the stage.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to present advertisements on a background of a stage in a musical event for the desirable benefit of providing the advertisements to a wider range of audiences.

9. Claims **7** and **8** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser (WO 98/28906) in view of Tanabe et al. (US 20010027559 A1).

Regarding **claim 7**, Rosser discloses that a central studio site 34 would also be responsible for supplying conventional video advertising *(see page 9, lines 25-26)*.

Rosser does not explicitly disclose that the advertisements are updated in real time.

However, Tanabe et al. teach that the advertiser can update the contents of the advertising information any time when the need arises, so that the viewer can view the latest advertising information *(see page 3, 0032; page 4, 0059; page 10, 0146)*.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Rosser by updating the advertisements any time when the need arises as taught by Tanabe et al. to allow the viewer viewing the latest advertising information.

Regarding **claim 8**, Rosser as modified by Tanabe et al. disclosing the advertisements are updated by the content provider or advertisement sponsor *(Tanabe et al. disclose that the advertiser can update the contents of advertising information –see page 3, 0032; page 4, 0059; page 10, 0146).*

10. Claims **10** and **11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser (WO 98/28906) in view of Stautner et al. (US 6,172,677 B1).

Regarding **claim 10**, Rosser does not explicitly disclose that the program is an interactive program in which the advertisements are updated based on responses of the user to the interactive program.

However, Stautner et al. teach that an interactive program, i.e., a integrated content guide, in which the advertisements can be easily accessed in a user's moment of interest. Particularly, after selecting an individual icon on the screen, this includes the display, using for example either an embedded browser or an automatically launched separate browser application, and following of hypertext markup line pages which may have active links which will cause further actions in a conventional manner of web browser or by using other types of search engines. For instance, an user selects icon 70 in the integrated content guide, advertising content is displayed on a browser which may have active links for further actions such as link to web pages *(see figure 2, col. 5, lines 15-36).*

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of Rosser by providing an interactive program,

i.e., a integrated content guide, in which the advertisements are updated, i.e., advertisement includes active links to link to web pages, based on responses of a user to the interactive program as taught by Stautner et al. in order to allow a user to access the additional related services and/or information of advertisement in a convenient manner.

Regarding **claim 11**, Rosser as modified by Stautner et al. further shows that the user is given the option of performing on-line or off-line transactions in response to the advertisements *(for instance, as shown in figure 2, Pizza Hut advertisement includes telephone number for the user makes an order anytime at anywhere. The user can select icon 40 to place an order on-line. By selecting icon 40, an automated sequence of events performed by the computer would then extract a proper telephone number from the data base, dial the particular number and place the user in a situation where they are in voice contact with the pizza restaurant or alternatively, provide for an automatic selection of the specifications of their desired pizza – see Stautner: figure 2 and col. 5, lines 25-28; col. 6, lines 50-59).*

11. Claim **12** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser (WO 98/28906) in view of Gautier (US 6,618,858 B1).

Regarding **claim 12**, Rosser discloses that the central controller is to carry out the viewer instructions by setting up the appropriate connections between all the appropriate modules within the set top device. This includes selection of the modem, cable modem, tuner or decoder as the primary receiving device; setting up of that primary receiving device to the appropriate channel, bandwidth or address to receive the data or program requested by the user *(see page 15, lines 18-32).*

Rosser does not explicitly disclose a login process including the steps of determining an identity and location of the user; organizing the identity and location information into a suitable

information packet; and storing the packet in the user's computing device or in computing devices located in the premises of the provider.

However, Gautier teaches that when a viewer logs onto services through an advanced set-top-box (ASTB), the viewer enters a TV name which is used to identify that viewer's account or identity locally on the ASTB. The viewer also enters a PIN and a service he/she wants to access. This information is then used on the local ASTB to retrieve a UID. The UID along with other information is transmitted over the network to the MSO. The MSO uses the UID to retrieve any information it needs to process the viewer's requests *(see figure 3; col. 7, lines 21-36 and col. 7-8, lines 61-4).*

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Rosser by including login process as taught by Gautier in order to verify the viewer identification for accessing the service.

12. Claim **13** is rejected under 35 U.S.C. 103(a) as being unpatentable over Rosser (WO 98/28906) in view of Stautner et al. (US 6,172,677 B1) and further in view of Tomsen (US 20020016965 A1).

Regarding **claim 13**, the combination teaching of Rosser and Stautner et al. does not explicitly disclose the steps of permitting the user to select whether to accept updating of the user's computing device.

However, Tomsen teaches that a television commercial displays a prompt that asks the viewer whether the viewer wishes to "Buy now" or "Buy later". If the viewer clicks the "Buy now" selection in response to the prompt, then additional commands can be sent from the set top box to the participating merchant to allow the viewer to conduct and complete the transaction. If the viewer clicks the "Buy later" selection in response to the prompt, then the transaction is

deferred. Deferral of the transaction includes saving information in the set top box (*see page 4, 0034-0037*).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the combination teaching of Rosser and Stautner et al. by permitting the user to select whether to accept updating of the user's computing device, i.e., order an advertised product now or later, as taught by Tomsen in order to allow the viewer begin a transaction to order the advertised product, or save information related to that television commercial in a convenience manner.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Rosser et al. (US 5,264,933 A) disclose an apparatus and method employ a pattern recognition algorithm such as the Burt Pyramid Algorithm for altering video images to enable the addition of images, message, slogans or indicia in such a manner that they appear to be part of the original image as displayed.

DiCicco et al. (US 5,892,554 A) disclose a system and method for inserting static and dynamic images into a live video broadcast.

Kreitman et al. (US 5,491,517 A) disclose a system for implanting an image into a video stream.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 703-306-5976. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on 703-305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

Ngoc K. Vu
Examiner
Art Unit 2611

November 13, 2003